



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,950	01/11/2005	Alistair John Knox	P60497US00	4787
27683 7590 09/08/2009 HAYNES AND BOONE, LLP IP Section 2323 Victory Avenue Suite 700 Dallas, TX 75219				
EXAMINER VAUGHAN, MICHAEL R				
ART UNIT 2431		PAPER NUMBER		
MAIL DATE 09/08/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,950

Applicant(s)

KNOX ET AL.

Examiner

MICHAEL R. VAUGHAN

Art Unit

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/6/09 has been entered.

Claims 40-79 are pending. Claims 40, 49, 51, 55, 57-58, 60, 65, 67, and 75-77 have been amended. Claims 78 and 79 are newly added.

Response to Amendment

Claim Objections

Claim objections are withdrawn due to amendments.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 40-79 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new amendments to the independent claims do not have support in the originally filed specification. It can be assumed one of ordinary skill in the art knows that a CD optical disc has a session which has a main data channel and a plurality of sub-code channels. Even though the term 'main data channel' is not used in the specification, the requirement of sub-code channels inherently distinguishes them from a main data channel. However, the lack of support for explicitly disclosing that both the primary track and the alternate track are in the main channel fails the written description requirement. This feature is not inherent or obvious. The prior art of Alcalay teaches storing the alternate tracks in the sub-channels of the session (col. 7, lines 30-35). Therefore, because the prior art taught a feature contrary to this new limitation, one cannot assume one of ordinary skill in the art would not have known from the instant application that both the primary and alternate tracks were both stored in the main data channel. As a result, this feature would have needed explicit support in the originally filed written disclosure. The only pertinent disclosure Examiner could find was that both the alternate and primary tracks were stored in a session (0049).

Response to Arguments

Applicant's arguments filed 7/17/09 have been fully considered but they are not persuasive. Because of the aforementioned 112 first paragraph problems, Examiner is interpreting the new limitations in the broadest scope for which a session does include both a main data channel and sub-code channels and both the primary track and alternate tracks are in that single session.

With respect to the argument over the meaning of an optical disc data reader, Examiner relies upon the meaning explicitly disclosed in paragraph 0013 of the instant application. The claims will be examined in light of this disclosure that an optical disc data reader is a conventional CD-ROM type player not a traditional CD audio player.

The Babowicz reference teaches storing primary and alternate tracks on more than one session. However, Alcalay explicitly teaches that alternate tracks can be stored in the sub-code channels of a session along with the primary tracks (col. 7, lines 32-35). Examiner maintains that it would have been obvious modify Babowicz in this manner and store both tracks in the same session.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babowicz (PCT WO 2002/075735 A1) in view of USP 6,988,206 to Alcalay et al., hereinafter Alcalay.

As per claim 40, Babowicz teaches an optical disc comprising:

a session having a main data channel and a plurality of sub-code channels (pg. 9, lines 15-20);

at least one primary track (Fig 2, 204);

at least one alternate track (Fig. 2, 208); and

disc data access information, stored upon the disc, and which is read and utilized only by an optical disc data reader, the disc data access information being such as to prevent location of the, or at least one of the, primary track(s), when the disc is read by the optical disc data reader, and to direct the optical disc data reader instead to the, or an associated, alternate track (page 3, lines 10-13, and 7, lines 10-15). Babowicz is silent in disclosing that both the primary track and alternate track are in a single session. Alcalay teaches a similar system as Babowicz including having the primary track and the alternate track in two different sessions as well. Alcalay teaches this is an alternative to having both the primary and second track in one session (col. 2, lines 55-63; and col. 7, lines 30-35. Alcalay teaches one can place the alternative tracks in sub-

code channels, the lead-in, and the lead-out areas of the session. Alcalay's invention, both the single session embodiment and the multi-session embodiment achieve the same results. Therefore it appears the choice of putting the alternative and primary tracks together in one session is a design choice. As such, one of ordinary skill in the art could choose either method since both methods are known. Substituting equivalent known method is within the ordinary capabilities of one of ordinary skill in the art.

As per claim 41, Babowicz teaches there are a plurality of primary tracks and a plurality of alternate tracks, at least one of the primary tracks having an associated alternate track (page 5, lines 14-18).

As per claim 42, Babowicz teaches the, or at least one, primary track is an audio track encoding audio information capable of playback by a CD audio player (pg. 5, line 13), and wherein the, or at least one, alternate track is a data track encoding audio information capable of playback by an optical disc data reader (pg. 5, lines 20-21).

As per claim 43, Babowicz teaches the audio information encoded within a primary track on the optical disc, when played back by a CD audio player, corresponds substantially with the audio information encoded within an associated alternate track when played back by an optical disc data reader (pg.5 , lines 15-21).

As per claim 44, Babowicz teaches the audio information encoded within a primary track on the optical disc, when played back by a CD audio player, is of different length and/or different audio content to the audio information encoded within an

associated alternate track when played back by an optical disc data reader (pg. 3, line 11).

As per claim 45, Babowicz teaches each of the primary tracks has an associated alternate track (pg. 5, lines 15-17).

As per claim 46, Babowicz teaches a table of contents (TOC) which includes the disc data access information that is read only by the optical disc data reader (pg. 11, lines 15-20).

As per claim 47, Babowicz teaches there are m [a number] primary tracks and n [a number] alternate tracks, the disc access information indicating to an optical disc data reader that there are only m tracks in total upon the optical disc (page 5, lines 24-25).

As per claim 48, Babowicz teaches the TOC further comprises disc audio access information that is readable by a CD audio player (page 7, line 7).

As per claim 49, Babowicz teaches the disc audio access information indicates to a CD audio player that there are only m tracks in total upon the disc, the disc data access information causing a first m of the m primary and n alternate tracks to be accessible to an optical disc data reader and the disc audio access information causing a second, different m of the m primary and n alternate tracks to be accessible by a CD audio player (page 7, lines 5-10). Babowicz explicitly references use of the industry standard for playing CDs.

As per claim 50, Babowicz the disc audio access information indicates to a CD audio player that there are m primary tracks only, and wherein the disc data access information indicates to an optical disc data reader that there are n alternate tracks and

(m-n) primary tracks (page 5, lines 2—25). Examiner acknowledges Applicant's use of the m and n variables as a way to logically reference the tracks in a clear manner. However no patentable weights is given to these values because they are used to merely explain that CD players access only the m tracks and the CD readers access only alternate tracks.

As per claim 51, Babowicz teaches the disc access information is included within a table of contents (TOC) of the optical disc, the TOC having a track number indicator indicative of the track number for each of the tracks on the disc (Fig 9), and wherein the track number indicator for the or each primary track which has an associated alternate track is set to zero (pg. 17, line 11).

As per claim 52, Babowicz teaches the disc access information is included within a table of contents (TOC), the TOC including entries for the or each alternate track (pg. 7, lines 18-23) for which there is a corresponding primary track but having no entries for each such corresponding primary track (pg. 8, lines 15-17).

As per claim 53, Babowicz teaches the disc access information is included within a table of contents (TOC), the TOC including timing entries indicative of a start time for the tracks (page 5, lines 22-25), and wherein the start time in the timing entry of at least one of the primary tracks is replaced with the start time of its corresponding alternate track (page 12, lines 19-23).

As per claim 54, Babowicz teaches the disc access information is included within a table of contents (TOC) (Fig 9), the TOC comprising track number entries for each of the tracks on the optical disc (Fig 6) Babowicz is silent in explicitly disclosing the track

number entry or entries in the TOC for the or each primary track are swapped with the respective track number entry or entries for the or each of the corresponding alternate tracks. However digital music is selected by numbers which indicates tracks. Whether it is from a CD or play list, it is notoriously well-known in the art that digital music is selected via track number when playing on a PC from some medium. Therefore it would have been obvious to give the alternate tracks numbers for identification to the user. As such, giving the tracks numbers which correlate to those on the back of the CD album cover would be beneficial to the user so he/she would know exactly which song they were selecting to play. It would have been obvious to one of ordinary skill at the time of the invention to modify Babowicz's invention to swap the track number of the alternate data with the primary data so that a user when playing the protected tracks would be able to identify them for play.

As per claim 55, Babowicz teaches the TOC includes a total track quantity entry indicative of the total number of tracks upon the disc, and wherein that total track quantity entry indicates only the total number of primary tracks upon the disc (Fig 9).

As per claim 56, Babowicz teaches the track number indicator for the or each alternate track which has a corresponding primary track is set to indicate the track number of the corresponding primary track (page 5, lines 23-25).

As per claim 57, Babowicz teaches substitute disc access information stored upon the disc in encrypted form, the substitute disc access

information, when decrypted, being usable by an optical disc data reader, when so decrypted, to permit location of the primary track(s) (page 5, lines 14-18).

As per claim 58, Babowicz teaches computer program code upon the disc and which, when executed, causes a computer which includes the optical disc data reader to access and decrypt the substitute disc access information, and to cause the optical disc data reader then to use the decrypted disc access information to locate tracks upon the disc (page 8, lines 5-20).

As per claim 59, Babowicz teaches the substitute disc access information permits location only of the primary tracks once the said substitute disc access information has been decrypted (page 5, lines 20-22).

As per claim 60, Babowicz teaches substitute disc access information is stored upon the disc as an alternate track (page 5, lines 20-22).

As per claim 61, Babowicz teaches at least one of the alternate tracks comprises compressed or encrypted data (page 8, line 13).

As per claim 62, Babowicz teaches the compressed data represent an audio signal encoded to a standard such as MP3 (page 8, line 15).

As per claim 63, Babowicz teaches at least one of the alternate tracks, incorporates a digital rights management technique (page 8, lines 19-20).

As per claim 64, Babowicz teaches at least one of the alternate tracks, incorporates copy protection (page 5, line 24).

As per claim 65, Babowicz teaches a method of generating data for writing onto an optical disc, the method comprising:

a session having a main data channel and a plurality of sub-code channels (pg. 9, lines 15-20);

generating primary data representative of m primary track(s) for the optical disc for writing to the main data channel of the session (page 7, line 5; Fig 4, 400);

generating alternate data representative of n alternate track(s) for the optical disc for writing to the main data channel of the session (page 8, lines 14-15; Fig 4, 408; and

assembling a table of contents (TOC) for the optical disc (Fig 4, 404), the TOC containing disc access control information which, when written to an optical disc, indicates to an optical disc data reader that there are m tracks in total written upon that optical disc (page 5, lines 20-25; Fig 9). Babowicz is silent in disclosing that both the primary track and alternate track are in a single session. Alcalay teaches a similar system as Babowicz including having the primary track and the alternate track in two different sessions as well. Alcalay teaches this is an alternative to having both the primary and second track in one session (col. 2, lines 55-63; and col. 7, lines 30-35. Alcalay teaches one can place the alternative tracks in sub-code channels, the lead-in, and the lead-out areas of the session. Alcalay's invention, both the single session embodiment and the multi-session embodiment achieve the same results. Therefore it appears the choice of putting the alternative and primary tracks together in one session is a design choice. As such, one of ordinary skill in the art could choose either method

since both methods are known. Substituting equivalent known method is within the ordinary capabilities of one of ordinary skill in the art.

As per claim 66, Babowicz teaches wherein the disc access control information further indicates to a CD-DA player that there are m tracks in total written upon that optical disc, the disc access information causing a different m of the $m+n$ tracks to be accessible to an optical disc data reader than the m tracks which are accessible by a CD-DA player (page 7, line 5-10). Babowicz explicitly references use of the industry standard for playing CDs.

As per claim 67, Babowicz teaches writing the generated primary and alternate data to an optical disc (Fig. 4, 400 and 408);

reading back the data thus written, including an unmodified TOC including unmodified disc access information for all of the $m+n$ tracks, to a data analysis device [must be read in, in order to modify contents] (Fig 4, between 400-402) ; and

editing the unmodified TOC so as to produce a modified TOC containing the said disc access control information indicative to a CD audio player of the presence of the m primary tracks, and to an optical disc data reader of the presence of n alternate tracks and $m-n$ primary tracks (Fig 4, 404).

As per claim 68, Babowicz teaches wherein the unmodified TOC further comprises a plurality of track number indicators, the method further comprising editing

the unmodified TOC so as to alter the track number indicators for at least some of the primary tracks (page 17, line 11).

As per claim 69, Babowicz teaches the step of editing the unmodified TOC comprises setting to zero the track number indicators of those primary tracks which are to be altered, so that an optical disc data reader no longer detects the presence of the said altered primary track number indicator(s) (page 17, line 11).

As per claim 70, Babowicz teaches the step of editing the unmodified TOC comprises deleting those parts of the TOC relating to at least some of the m primary tracks [setting value to 0 constitutes deletion] (page 17, line 11).

As per claim 71, Babowicz teaches at least one of the m primary tracks has a corresponding alternate track (page 5, lines 20-25). Babowicz is silent in expressly disclosing the step of editing the unmodified TOC further comprising replacing the track number indicators of each of the alternate tracks which has a corresponding primary track with the track number indicator of that corresponding primary track in the unmodified TOC. However digital music is selected by numbers which indicates tracks. Whether it is from a CD or play list, it is notoriously well-known in the art that digital music is selected via track number when playing on a PC from some medium. Therefore it would have been obvious to give the alternate tracks numbers for identification to the user. As such, giving the tracks numbers which correlate to those on the back of the CD album cover would be beneficial to the user so he/she would

know exactly which song they were selecting to play. It would have been obvious to one of ordinary skill at the time of the invention to modify Babowicz's invention to replace the track number of the alternate data with the primary data so that a user when playing the protected tracks would be able to identify them for play.

As per claim 72, Babowicz is silent in explicitly disclosing the track number entry or entries in the TOC for the, or each, primary track are swapped with the respective track number entry or entries for the or each of the corresponding alternate tracks. However digital music is selected by numbers which indicates tracks. Whether it is from a CD or play list, it is notoriously well-known in the art that digital music is selected via track number when playing on a PC from some medium. Therefore it would have been obvious to give the alternate tracks numbers for identification to the user. As such, giving the tracks numbers which correlate to those on the back of the CD album cover would be beneficial to the user so he/she would know exactly which song they were selecting to play. It would have been obvious to one of ordinary skill at the time of the invention to modify Babowicz's invention to swap the track number of the alternate data with the primary data so that a user when playing the protected tracks would be able to identify them for play.

As per claim 73, Babowicz teaches the step of editing the TOC comprises replacing the start time of the, or at least one of the, primary tracks (page 5, lines 22-25) with the start time of an associated alternate track (page 12, lines 19-23).

As per claim 74, Babowicz teaches the unmodified TOC further includes a total track quantity entry, the step of editing the unmodified TOC comprising reducing the

total quantity of tracks in the total track quantity entry so that it indicates, in the modified TOC, only the number of primary tracks present (Fig 4, 404).

As per claim 75, Babowicz teaches a method of controlling access by an optical disc data reader to an optical disc having a session that has a main data channel and a plurality of sub-code channels (pg. 9, lines 15-20);

and at least one primary track and at least one alternate track formed within the main data channel (page 8, lines 14-15), the method comprising the step of preventing the location of the, or at least one of the, primary track(s) when the disc is read by the said optical disc data reader (page 7, line 5), and directing the data reader instead to the, or an associated, alternate track [data within session 2] (page, 7, lines 5-10). Babowicz is silent in disclosing that both the primary track and alternate track are in a single session. Alcalay teaches a similar system as Babowicz including having the primary track and the alternate track in two different sessions as well. Alcalay teaches this is an alternative to having both the primary and second track in one session (col. 2, lines 55-63; and col. 7, lines 30-35. Alcalay teaches one can place the alternative tracks in sub-code channels, the lead-in, and the lead-out areas of the session. Alcalay's invention, both the single session embodiment and the multi-session embodiment achieve the same results. Therefore it appears the choice of putting the alternative and primary tracks together in one session is a design choice. As such, one of ordinary skill in the art could choose either method since both methods are known.

Substituting equivalent known method is within the ordinary capabilities of one of ordinary skill in the art.

As per claim 76, Babowicz teaches method further comprising allowing the location only of the primary track when the disc is read by a CD-DA player (pg. 5, lines 20-25).

As per claim 77, Babowicz teaches the disc has m primary tracks and n alternate tracks, the method further comprising permitting access to the n alternate track(s) and (m-n) of the primary tracks when the disc is accessed by an optical disc data reader (page 5, lines 16-26), and

permitting access to the m primary tracks when the said disc is accessed by a CD-DA player (page 8, lines 1-2). Examiner acknowledges Applicant's use of the m and n variables as a way to logically reference the tracks in a clear manner. However no patentable weights is given to these values because they are used to merely explain that CD players access only the m tracks and the CD readers access only alternate tracks.

As per claim 78, Babowicz teaches the disc data access information [TOC] is stored within the plurality of sub-code channels (page 10, lines 5-7).

As per claim 79, Babowicz teaches the TOC is stored within the plurality of sub-code channels in the session (page 10, lines 5-7).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is (571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on 571-272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./

Examiner, Art Unit 2431

/William R. Korzuch/

Supervisory Patent Examiner, Art Unit 2431